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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,275	08/01/2005	Wei-Ping Min	4767-217 LAB	9949
24223 7590 02/22/2007 SIM & MCBURNEY 330 UNIVERSITY AVENUE 6TH FLOOR TORONTO, ON M5G 1R7 CANADA			EXAMINER CHONG, KIMBERLY	
			ART UNIT 1635	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
31 DAYS			02/22/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/517,275

Applicant(s)

MIN ET AL.

Examiner

Kimberly Chong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 1-21, 23, 25, 26, 28-31, 34-37, 40, 46 and 49-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 22, 24, 27, 32, 33, 38-39, 41-45, 47, 48 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Election/Restrictions***

Applicant's election with traverse of group II, 22, 24, 2732, 33, 38, 39, 41-45, 47 and 48, a cytokine endogenous gene, an siRNA, and transplant rejection in the reply filed on 12/04/2006 is acknowledged. The traversal is on the ground(s) that group II is not distinct from groups I or III because they do share a common special technical feature but the traversal is moot because applicants have withdrawn the claims of groups I and III. Applicant further traverse the restriction of the endogenous genes, a construct, an immune disorder and a target gene. The traversal is on the ground(s) that there is no evidence that the search and examination for this claimed invention would be burdensome.

Applicant's argument is not found persuasive. As stated in the prior office action, a search for an endogenous gene, construct, an immune disorder and or a target gene is burdensome because the searches are not coextensive and a search for one endogenous gene such as a cytokine, for example, would not necessarily reveal art for a different endogenous gene such as an enzyme. Therefore the restriction requirement for the election of an endogenous gene, a construct, an immune disorder and a target gene is made FINAL.

As stated above, acknowledgement of group II, claims 22, 24, 2732, 33, 38, 39, 41-45, 47 and 48. However, this group is subject to a further restriction as follows.

Restriction is required under 35 U.S.C. 121 and 372.

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This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Furthermore, under PCT Rule 13.2 the requirement of unity of invention referred to in PCT Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 32, 33, 38, 39 and 41-45, drawn to a composition for the treatment of an immune disorder comprising at least one of a construct, a immune cell or a pharmaceutically acceptable carrier.

Group 2, claim(s) 22, 24, 27, 47 and 48 drawn to the use of a medicament comprising siRNA or hybrid DNA/RNA and to a method of decreasing the immunogenicity and rejection potential of an organ for transplantation and a method of decreasing the immunogenicity and rejection potential of an organ for transplantation..

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The inventions listed as Groups 1-2 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Unity of invention between different categories of inventions will only be found to exist if the specific combinations are present. These combinations include:

- 1) a product and special process of manufacture of said product,
- 2) a product and a process of use of said product,
- 3) a product, a special process of manufacture of said product, and a process of use of said product,
- 4) a process and an apparatus specially designed to carry out said process,
- 5) a product, a special process of manufacture of said product, and an apparatus specially designed to carry out said process.

The composition of group 1 cannot be said to be a special technical feature under PCT Rule 13.2 because at the time of filing, the element is shown in the prior art. U.S. Patent No. 6,506,559 teach a construct comprising a siRNA that inhibits expression of an endogenous target gene, such as a cancer gene encoding an enzyme for the treatment of an immune disorder (see Figure 5A, and column 10, lines 30-68 and column 11, lines 10-25). The reference also teaches a composition for the treatment of an immune disorder comprising at least one of a construct.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Chong whose telephone number is 571-272-3111. The examiner can normally be reached Monday thru Friday between 7-4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Schultz can be reached at 571-272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

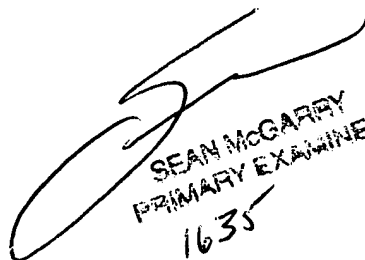
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for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Kimberly Chong  
Examiner  
Art Unit 1635



SEAN MCGARRY  
PRIMARY EXAMINER  
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